

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

QUAD INT'L, INCORPORATED,

Opposer,

vs.

ANDREA FISCHER,

Applicant.

Opposition No.: 91160119

Serial No.: 76/516972

Mark: CHLOE VEVRIER

Published: March 23, 2004

CERTIFICATE OF MAILING

I hereby certify that on **May 31, 2005**, this paper is being deposited with the U.S. Postal Service by "Express Mail Post Office to Addressee" service with Express Mail Label No. ED 830246667 US, for delivery to the United States Patent and Trademark Office, Madison Building, 600 Dulany Street, Alexandria, VA 22313.


LAURA GANOZA

**OPPOSER'S REPLY TO APPLICANT'S OPPOSITION TO
MOTION FOR SUMMARY JUDGMENT**

Opposer, Quad Int'l Incorporated, ("Opposer") by and through its undersigned counsel, hereby files its Reply to Applicant's Opposition to Opposer's Motion for Summary Judgment and, in further support of its Motion for Summary Judgment, states as follows:

INTRODUCTION

In her Opposition, Applicant repeatedly states that the name CHLOE VEVRIER (the "Challenged Trademark") is her "professional name" and virtually admits that she does not use this name as a trademark. Most telling, Applicant does not even attempt to respond to Opposer's argument (Section III of Opposer's Brief) that her application must be refused because the Applicant does not use the Challenged Trademark as a trademark. For this reason alone,

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There is no dispute that it was Opposer, not Applicant, and no amount of post-discovery disclosure that can change that reality. For this reason as well, Opposer's motion for summary judgment must be granted and Applicant's application must be refused registration.¹

ARGUMENT

I. APPLICANT FAILS TO ARGUE, MUCH LESS PROVE, THAT SHE WAS THE FIRST TO USE THE CHALLENGED MARK ON GOODS OR SERVICES.

Applicant states, *ad nauseum*, that she "conceived and created" the professional name, CHLOE VEVRIER. (Opposition Brief, pp. 2, 14) in February of 1992. Conspicuously absent is any assertion that she actually "used" the Challenged Trademark at that time. Indeed, Applicant concedes she has no promotional or advertising materials. In addition, Applicant does not deny her lack of domestic sales under the Challenged Mark. Instead, and rather predictably, Applicant centers her entire case on a hand-written notation contained in a May 30, 1992 Model Release. Given Applicant's burden to prove priority by clear and convincing evidence since the application contains a March, 2003 first use date, *Hydro-Dynamics, Inc. v. George Putnam & Co., Inc.*, 811 F.2d 1470, 1473 (Fed. Cir. 1987), this evidence is woefully insufficient. Stripped of its righteous rhetoric, Applicant's claim is little more than a plea premised on inferences founded on innuendo.

First, aside from Applicant's self-serving statements, no evidence exists in the record concerning *when* this notation was actually placed on the Release. Indeed, the notation may not have been included on the document at the time it was executed. At best, this document evidences that it was decided that Applicant would be called "CHLOE VEVRIER" at some point in time. The mere creation, or discussion of a trademark does not create priority rights. *See*

Opposer notes that Applicant also filed a Cross-Motion for Summary Judgment whereby she is seeking to dismiss the Opposition (Sections VII and VIII of Applicant's Opposition). Opposer will respond to Applicant's

Cross-Motion for Summary Judgment separately, and in due course, pursuant to the applicable TTAB rules.

Hydro-Dynamics, 811 F.2d at 1473. There must be actual use by affixing the trademark to the goods, and selling or transporting the marked goods in commerce. See *New England Duplicating Co. See New England Duplicating Co. v. Mendes*, 190 F.2d 415, 417-18 (1st Cir.1951). The only actual use on goods that is evidenced back in 1992, is use by the *Opposer* in its publications. See Exhibits I, J, L and M.

Even if the notation was contemporaneous with the signing of the release, this notation "TO BE CALLED: CHLOE VEVRIER," does not establish *actual use in commerce*, and it is certainly not a trademark license.² There is no requirement that Applicant *must* be called "CHLOE VEVRIER," nor is there a prohibition on the use of any other name. In fact, there is nothing in this particular release, or any other release submitted and contained in the record, that evidences that Applicant must exclusively be called CHLOE VEVRIER. For example, the May 20, 1992 release itself states that Applicant's photos may be used "alone or in conjunction *with any wording . . .*" In addition, some of the other releases even authorize Opposer to use Applicant's real name. See Exhibit Q, February 21, 1999 Model Release (Bates No. Q01614) (containing no reference whatsoever to the Challenged Trademark).

Even in the event the Board were to accept the argument that the "to be called" notation *required* others to use the Challenged Trademark, such an argument does not, *ipso facto*, mean that Applicant exercised quality control over the Challenged Trademark. See *Malibu, Inc. v. Reasonover*, 246 F. Supp. 2d 1008, 1014-15 (N.D. Ind. 2003) (holding that merely giving

² According to Applicant, the May 20, 1992 release was signed in London, England. Applicant concedes that even if the designation in the release could be stretched to denote "use," use in a foreign country does *not* entitle its owner to claim exclusive trademark rights in the United States. In order to side step this issue, Applicant claims that "Opposer, through the [sic] its agent John Graham, knew that Applicant intended to render her modeling services in the United States utilizing the CHLOE VEVRIER name." There is absolutely no support in the record for this assertion. Indeed, Applicant does not cite any portion of the record to support this allegation. Given the utter lack of evidentiary basis for this self-serving assertion, Applicant's desperate attempt to circumvent the requirement for use in the United States must be disregarded in its entirety.

someone permission to use the mark does not establish ownership). None of the model releases contain a single phrase that could be construed to grant Applicant control of the way the Challenged Trademark is used. In fact, the agreements signed by Applicant, and Applicant's course of conduct for that last decade, indisputably proves that Applicant exercised absolutely no quality control over the use of the Challenged Mark. The exclusive agreement with Opposer in 2000 expressly states that Applicant had "no right whatsoever to review or control any and all editorial content posted on Chloe's World whether said editorial content is written or photographic." Exhibit A, at ¶ 6. Similarly, the model releases executed by this Applicant establish that Opposer had the "unconditional and irrevocable right to use, copyright and publish any photographs of [Applicant], **accompanied by either my real name or by a fictitious name.**" See Exhibit Q, February 21, 1999, Model Release (Bates No. Q01614). The model release further states that Applicant "**waive[s] any right to inspect or approve the manner in which my photographs or accompanying material appears in printed form.**" *Id*

Applicant's claim that she satisfied her obligation to control the use of the Challenged Mark merely by telling John Graham that her photos should not be used with any other name further highlights the weakness of her ownership argument. As set forth in *Halo Management, LLC v. Interland, Inc.*, 308 F. Supp. 2d 1019, 1030 (N.D. Cal.2003), a case Applicant completely ignores, a trademark owner must exercise more than "minimal efforts" to control the quality of the goods/services sold under its mark. Here, Applicant failed to take any affirmative action to secure her perceived rights. Indeed, she expressly waived any right to do so.

Finally, even the "newly discovered documents" fail to assist Applicants in her cause. Although Opposer asserts that the Board should disregard Applicant's Exhibit 43 in its entirety due to Applicant's failure to produce this document during discovery, if the Board considers this

document, it would inevitable benefit Opposer. It is undisputed that Opposer's first use of the Challenged Trademark occurred in November of 1992 when the January issues of *SCORE* and the *Best of Score* went on sale. Under any analysis, this is the earliest use of the Challenged Trademark listed in Applicant's own Exhibit 43. All of these dates are corroborated by John Fox, Opposer's President, notwithstanding Applicant's baseless and unfortunate attacks on Mr. Fox's credibility. The next purported use (not by Applicant, but by a competing publisher *Juggs*) occurred the following month, February of 1993. Accordingly, Applicant's reliance on this purported evidence contradicts her claims of prior use.

For all of these reasons, Applicant cannot establish the most fundamental requirements for trademark registration -- ownership/priority of use. Accordingly, Applicant's registration must be refused.

II. APPLICANT DOES NOT REFUTE HER LACK OF USE OF THE NAME CHLOE VEVRIER AS A TRADEMARK.

Applicant admits that the name Chloe Vevrier is nothing more than her professional name. In fact, in her opposing papers, Applicant does not even attempt to refute Opposer's arguments that the Challenged Trademark lacks use as a trademark. The reason for this omission is obvious: Applicant is unable refute this argument because she cannot demonstrate that she uses the Challenged Trademark in a trademark sense. By her constant admission, the Challenged Trademark merely identifies her as an individual, and Applicant cannot demonstrate that the Challenged Trademark identifies and distinguishes the website services recited in the application. For this reason alone, Applicant's registration must be refused.

III. APPLICANT'S FRAUD ON THE TRADEMARK OFFICE MANDATES REFUSAL OF THE REGISTRATION.

Unlike Applicant contends, in order to establish fraud on the Trademark Office, Opposer need not prove a specific intent to commit fraud. *See First International Services Corporation v. Chuckles, Inc., Dba Sukesha* 1988 WL 252292 (TTAB 1988) ("We recognize that it is difficult, if not impossible, to prove what occurs in a person's mind, and that intent must often be inferred from the circumstances and related statement made by that person."); *General Car and Truck Leasing Systems Inc. v. General Rent-A-Car, Inc.*, 1990 WL 359368 (S.D. Fla. 1990) ("proof of specific intent to commit fraud is not required, rather, fraud occurs when an applicant or registrant makes a false material representation that the applicant or registrant knew or should have known was false"); *Western Farmers Association v. Loblaw Inc.* 1973 WL 19717 (TTAB 1973). As even a case cited by Applicant holds, "it is sufficient to prove that at the time of the application for registration that registrant knew that others had the right to use and were using" the Challenged Trademark on the goods listed in the application. *See Bart Schwartz Int'l Textiles, Ltd. v. FTC*, 129 U.S.P.Q. 258, 260 (CCPA 1961).

In the instant case, Applicant knew that Opposer was using the Challenged Trademark when she signed the application. It cannot be undisputed that Opposer launched a website in 1998, *five years prior* to Applicant's first use of the mark on a her own website in 2003. Applicant also knew that for approximately a decade prior to that Opposer expended hundreds of thousands of dollars in advertising and promotional expenses in connection with the Challenged Trademark. Applicant also knew Opposer derived significant sales through its promotion of the mark. In the face of all this knowledge, Applicant claimed she was the exclusive user of the

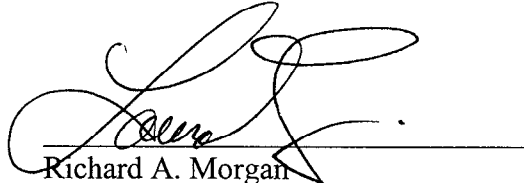
Challenged Trademark. Applicant's assertions are disingenuous, plain and simple, and Applicant's application should be summarily refused.

CONCLUSION

This Board must reject Applicant's attempt to register her "professional name." Not only does Applicant fail to use the Challenged Trademark in a trademark sense, the undisputed evidence conclusively establishes that Applicant is not the exclusive owner of the mark. Moreover, Applicant herself knew this fact, and neglected to inform the Trademark Office, when she filed the application. For all these reasons, summary judgment in favor of Opposer should be granted and Applicant's application for registration should be denied.

Respectfully submitted,

BUCHANAN INGERSOLL P.C.
Attorneys for Opposer
Bank of America Tower, 34th Floor
100 Southeast Second Street
Miami, Florida 33131
Tel: (305) 347-4080
Fax: (305) 347-4089

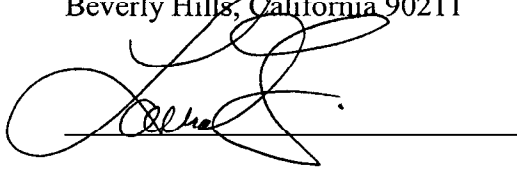


Richard A. Morgan
Florida Bar No.: 836869
morganra@bipc.com
Laura Ganoza
Florida Bar No.: 0118532
ganozal@bipc.com

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing REPLY TO APPLICANT's
OPPOSITION TO MOTION FOR SUMMARY JUDGMENT was served this 31st day of May,
by mailing by first class mail, postage prepaid, on the attorney named below:

Michael A. Painter, Esq.
Isaacman, Kaufman & Painter
8484 Wilshire Boulevard, Suite 850
Beverly Hills, California 90211

A handwritten signature in black ink, appearing to read "Michael A. Painter", is written over a horizontal line.